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Paper No. 11
Bottorff

10/4/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re DML Marketing Group, Inc.

Serial No. 75/308,640

George J. Netter for DML Marketing Group, Inc.

Jill C. Alt, Trademark Examining Attorney, Law Office 114
(Conrad Wong, Acting Managing Attorney)

Before Seeherman, Quinn and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark DAKOTA BLUE, in typed form, for goods
identified in the application as "clothing, namely,
anklets, knee highs, thigh highs and tights."¹ Pursuant to
the Trademark Examining Attorney's requirement, applicant

¹ Serial No. 75/308,640, filed June 13, 1997. The application is based on use in commerce, and December 4, 1996 is alleged in the application as the date of first use of the mark anywhere and first use of the mark in commerce.

has disclaimed the exclusive right to use BLUE apart from the mark as shown.

The Trademark Examining Attorney has refused registration of applicant's mark on the ground that the mark, as applied to applicant's goods, so resembles the mark DAKOTA, registered for "snowmobile suits, jackets, coats, coveralls, ski pants and jackets, jumpsuits and jackets,"² as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d). When the refusal was made final, applicant filed this appeal. Applicant and the Trademark Examining Attorney filed main briefs, but applicant did not file a reply brief. No oral hearing was requested.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the

² Registration No. 941,497, issued August 22, 1972, renewed September 3, 1992. Affidavits under Trademark Act Sections 8 and 15 accepted and acknowledged.

essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor to consider is whether applicant's mark DAKOTA BLUE and the registered mark DAKOTA, when considered in their entirety as to appearance, sound and connotation, are similar or dissimilar. For the reasons stated below, we find that the two marks are similar, rather than dissimilar.

Although the ultimate conclusion as to the similarity or dissimilarity of the marks rests on consideration of the marks in their entirety, it is not improper to state that, for rational reasons, more or less weight has been given to a particular feature of the mark. *In re National Data Corporation*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985). In this case, we find that DAKOTA is the dominant feature of applicant's mark DAKOTA BLUE because, as applied to applicant's goods, DAKOTA is an arbitrary term or at most a slightly suggestive term, while, as applicant has acknowledged by agreeing to the Examining Attorney's requirement for a disclaimer, BLUE is the name of a common, primary color which is either merely descriptive or deceptively misdescriptive of the goods.

More specifically, we find that DAKOTA dominates the commercial impression of applicant's mark for the following reasons. It appears on this record that DAKOTA is an arbitrary term as applied to applicant's goods. Although applicant's dictionary evidence shows that "Dakota" was the name of a former U.S. territory, there is no evidence that the term is now used or recognized as the name of any specific geographic place, much less a geographic place that has anything to do with applicant's goods. Likewise, applicant's dictionary evidence shows that DAKOTA is the name of a group of Indian tribes, a fact which has no effect on the arbitrariness of the term as applied to applicant's goods. Finally, there is no evidence of any use by third parties of the term DAKOTA, or any term similar thereto, in connection with the types of goods involved in this case or in connection with any goods or services at all, a fact which leads us to conclude that DAKOTA is relatively strong as a source indicator.

In contrast, the term BLUE contributes relatively little to the commercial impression created by applicant's mark DAKOTA BLUE. It is the name of a common color, and as such it would be perceived by purchasers as either descriptive or misdescriptive of a feature of applicant's goods, i.e., the color of the goods. We base this finding

on the numerous third-party registrations made of record by the Trademark Examining Attorney, in which various clothing items are included in the respective identifications of goods and in which the word BLUE appears in the respective marks but is disclaimed. Indeed, applicant itself has disclaimed the word BLUE in its application. Although we cannot ignore a disclaimed term in our determination of the similarity or dissimilarity of the marks, the fact that BLUE was disclaimed by applicant further supports our finding that BLUE contributes less to the commercial impression that applicant's mark would make on purchasers. See *In re National Data Corp.*, *supra*.

Having found, for the above-stated reasons, that DAKOTA is the dominant feature of applicant's mark DAKOTA BLUE and that it accordingly is entitled to greater weight in our determination of the mark's commercial impression than is the term BLUE, we now proceed to a comparison of applicant's and registrant's marks, in their entireties, as to appearance, sound and connotation.

With respect to appearance and sound, the two marks obviously are identical to the extent that they both include the word DAKOTA, but they are dissimilar to the extent that applicant's mark, but not registrant's mark, also includes the word BLUE. However, for the reasons

previously discussed, we find that it is the presence of the word DAKOTA in both marks, rather than the presence or absence of the common word BLUE, that is more likely to be noticed and recalled by purchasers who encounter the marks. On balance, therefore, we find that the similarity between the marks, i.e., their shared use of the word DAKOTA, outweighs the dissimilarities between the marks resulting from the presence of the word BLUE in applicant's mark. We conclude that the marks, considered in their entirety, are similar rather than dissimilar in terms of appearance and sound.

As for the connotation of the respective marks, applicant's dictionary evidence shows that DAKOTA would connote or suggest to purchasers the aforementioned former U.S. territory and/or the group of American Indian tribes and their language. When compared in their entirety, both marks convey the same connotation. Although applicant's mark also contains the word BLUE, that word, which is descriptive or misdescriptive of applicant's goods, is not sufficient, in itself, to eliminate the confusing similarity resulting from both parties' use of the arbitrary word DAKOTA as the dominant feature of their respective marks. *See, e.g., In re El Torito Restaurants*

Inc., 9 USPQ2d 2002 (TTAB 1988); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985).

We note applicant's contention that, by combining the word BLUE with the word DAKOTA, it has created a unitary composite, DAKOTA BLUE, which is distinguishable from DAKOTA, per se, in terms of connotation and commercial impression. More specifically, applicant contends that DAKOTA BLUE would be perceived by purchasers as the name of a color, i.e., a particular shade of blue. However, there is no evidence in the record that any such color exists, or that DAKOTA BLUE would be perceived as such a color when used in connection with applicant's goods. In the absence of such evidence, we cannot conclude that DAKOTA BLUE is a unitary composite term with its own distinctive meaning.³

In summary, we have carefully considered applicant's mark and registrant's mark in their entireties, and conclude, for the foregoing reasons, that the marks are similar rather than dissimilar in terms of their appearance, sound and connotation, and that they therefore

³ If the parties' marks were, for example, POWDER and POWDER BLUE, applicant's argument would be more persuasive. The addition of the word BLUE to the word POWDER results in a unitary composite, the well-known color "powder blue," which has a connotation quite different from the connotation of the word POWDER, per se. In this case, applicant has not shown that any such unitary composite is created by the combination of the descriptive word BLUE with the arbitrary and dominant word DAKOTA.

convey similar commercial impressions. This similarity between the marks weighs in favor of a conclusion that confusion is likely.

We turn next to a consideration of the commercial relationship, if any, between the respective goods identified in applicant's application and in the cited registration, i.e., between applicant's "clothing, namely, anklets, knee highs, thigh highs and tights" and registrant's "snowmobile suits, jackets, coats, coveralls, ski pants and jackets, jumpsuits and jackets." It is not necessary that these respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association or connection between the producers of the respective goods. *See In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Moreover, it is settled that if any of the goods identified in the applicant's

application are related to the goods identified in the cited registration, refusal of the application on the ground of likelihood of confusion is appropriate. See *Shunk Manufacturing Company v. Tarrant Manufacturing Company*, 137 USPQ 881 (CCPA 1963); *Alabama Board of Trustees v. BAMA-Werke Curt Baumann*, 231 USPQ 408 at fn. 7 (TTAB 1986).

In this case, we are persuaded by the Trademark Examining Attorney's contention that applicant's "tights" are complementary to and used in conjunction with the skiing and snowmobiling outerwear identified in the cited registration, and that these respective goods therefore are similar and related for purposes of our likelihood of confusion analysis. See, e.g., *In re Melville Corp.*, *supra*; *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984). More specifically, we find that the two types of products, i.e., tights and skiing or snowmobiling outerwear, would both be components of the outfit or ensemble worn by skiers or snowmobilers while pursuing their respective winter outdoor activities.

It is apparent from the third-party registration evidence made of record by the Trademark Examining Attorney that the term "tights" in applicant's identification of goods is broad enough to include tights used for athletic

or sports-related activities. Applicant has not restricted its identification of goods to exclude such type of tights, and it must be presumed that the "tights" identified in the application include tights used during athletic activity.

See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

It is common knowledge that one of the primary reasons that athletic tights are worn during outdoor activity is the warmth they provide to the wearer. It also is common knowledge that the activities of skiing and snowmobiling take place in the snow and in cold weather and locations, and that it is appropriate to "layer" one's clothing while engaging in these activities so as to ensure the appropriate degree of body warmth and comfort. Accordingly, a skier or snowmobiler could and would readily use athletic tights as the "first layer" of his or her layered outfit, underneath outerwear of the type identified in registrant's registration.

In view thereof, and in view of the fact that applicant has never contested the Trademark Examining Attorney's arguments regarding the complementary nature of applicant's tights and registrant's outerwear, we find that applicant's goods and registrant's goods, as identified in the respective application and registration, are similar

and related. This fact weighs in favor of a conclusion that confusion is likely.

Applicant argues that confusion is unlikely because the parties' respective goods are marketed in different trade channels. In support of this contention, applicant has submitted the declaration of its Operations Manager, Susie Koo. She states that registrant's types of goods are sold primarily in specialty sports stores or in the sports departments of department and chain stores, while applicant's own goods are sold in department stores and chain stores but not in stores specializing solely in sports clothing.

Ms. Koo's declaration is sufficient, in the absence of any contradictory evidence from the Trademark Examining Attorney, to establish that registrant's types of goods are normally sold in specialty sports stores or in the sports departments of department and chain stores. However, her declaration is insufficient to establish that the types of goods identified in the application, particularly "tights," are not sold in the same locations as well. As discussed above, applicant's "tights" are not limited in the identification so as to exclude athletic and sports tights. Likewise, applicant's identification of goods is not limited as to the types of retail facilities or department

store departments in which applicant's goods are offered for sale. We accordingly must presume that they are offered in all normal and usual trade channels for such goods, not just in the specific trade channels in which they are presently offered. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

In view of the complementary nature of applicant's "tights" and registrant's ski and snowmobile outerwear, it is entirely reasonable to assume that these goods would be offered for sale in the same locations and purchased at the same time. That is, "tights," as identified in the application and which would include athletic or sports tights, are presumed to be offered for sale in the same specialty sports stores and department store sports departments as registrant's outerwear. Thus, we find that the established and likely-to-continue trade channels for the parties' respective goods overlap, a fact which weighs in favor of a conclusion that confusion is likely.

In summary, we have carefully considered all of the evidence of record pertaining to the relevant *du Pont* likelihood of confusion factors, and conclude that confusion is likely to result from applicant's use of its

mark on its identified goods. To the extent that any of applicant's arguments raise a doubt as to that conclusion, we must resolve that doubt in favor of the prior registrant. *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The Section 2(d) refusal is affirmed.

E. J. Seeherman

T. J. Quinn

C. M. Bottorff

Administrative Trademark Judges
Trademark Trial and Appeal Board